

PATENT APPLICATION
ATTORNEY DOCKET NO. 70496

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

16 1/2

Applicants: David JENKINS et al.

Appln. No.: 09/777,979

Filed February 6, 2001

Title: MEDICAL IMPLANT FOR
ELECTRO-STIMULATION USING
DISCRETE MICRO-ELECTRODES

Group
Art Unit: Unassigned

Examiner: Unassigned

CERTIFICATE OF MAILING

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Registration No. 30,562
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DK

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR §1.182

Hon. Commissioner of Patents and Trademarks
Attention: Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The present request for reconsideration is in response to the "Decision on Petition" dated June 25, 2002, for the above-identified application, and which dismissed Applicant's Petition under 37 CFR §1.182 dated February 26, 2002. Applicants respectfully request reconsideration and that the drawings, copies of which were enclosed in the earlier filed Petition, are added to the specification and that the original filing date of February 6, 2001, be accorded to the present application. Should it be appropriate, Applicants respectfully request that this present request be treated as a separate Petition under 37 CFR §1.182 for the relief requested.

In this Reconsideration, Applicants wish to address two separate issues:

(1) In the Petition dated February 26, 2002, Applicants argued that drawings were fully described in the specification as filed and, thus, that the incorporation of the drawings would not constitute new matter. This issue was not addressed in the Decision on Petition.¹ Applicants respectfully request that the Office of Petitions address this issue.

As noted, Applicants believe that the specification as originally filed on February 6, 2001, fully enabled and provided written description of the invention in terms, and in sufficient detail, to allow one of ordinary skill in the art to fully understand and use the invention. Thus, Applicants believe that "a drawing is not necessary for the understanding of the invention but [that] the subject matter sought to be patented admits of illustration by a drawing." MPEP 608.02 (Handling of Drawing Requirements under Second Sentence of 35 U.S.C. 113). In such cases, the lack of a drawing does not render the application incomplete but rather is treated as an informality. In such cases, Applicants are allowed to provide the drawings so long as they do not introduce new matter.² *Id.*

The present invention is fully described and enabled in the specification as originally filed. The specification (see, e.g., page 16, line 10, through page 29, line 2) clearly provides a complete and detailed description of the invention in terms that allows one of ordinary skill in the art to fully understand and use the invention. Thus, one of ordinary skill in the art would find the invention enabled without the drawings. This is especially true since, as indicated on page 27, lines 12-21, earlier patents

¹ The Decision on Petition did indicate that Applicants argued that since "the drawings were in the possession of the Office at the time the subject application was filed, the drawings would not constitute new matter" (third paragraph). Applicants respectfully submit that this argument is significantly different from the argument that the specification as filed fully described the invention and the drawings, and that inclusion of the drawings would not constitute new matter.

² Since the drawings submitted with the original Petition in the present case could easily be compared with the drawings submitted with the provisional application, the determination that no new matter is being introduced can easily be confirmed.

and applications describing the basic electro-implant devices and immobilizing mechanisms are incorporated by reference in the present application. Thus, the inadvertent omission of the drawings should not render the application defective under 37 CFR §1.53. Moreover, and as indicated earlier, inclusion of the drawings as requested by the original Petition does not constitute new matter; all reference numbers and elements in the drawings as submitted with the original Petition are fully described in the specification as filed.

(2) As noted in the original Petition, the present application was filed on February 6, 2001. Unfortunately, the drawings were omitted with the application as filed. Based on a review of the file, the omission of the drawings appears to have been an oversight. This application was based on, and claimed benefit of, Provisional Applications 60/181,320 (February 9, 2000), 60/249,096 (November 15, 2000), and 60/249,654 (November 17, 2000). The full set of drawings were included in the provisional applications. These were the same set of drawings that were to be included in the present application but were omitted by error (and which were enclosed in the original Petition). Moreover, these same drawings were filed with the corresponding PCT application PCT/US01/03319 (filed February 1, 2001; copy enclosed in the original Petition). Applicants respectfully suggest that, since the actual drawings were on file in the United States Patent and Trademark Office in the form of the three provisional applications at the time the present application was filed and that the present application specifically claimed priority from and benefit of these provisional applications (which contained the drawings), that the drawings were in possession of the United States Patent and Trademark Office and thus were effectively included in the application as filed.

The Decision on Petition effectively rejected this last argument since Applicants did not include a specific statement in the specification as filed that the Provisional Application was "incorporated by reference." Applicants respectfully request reconsideration of the dismissal of the original Petition based on this ground.

The strict adherence to such a requirement in the present case is unnecessarily putting form before substance.³

As detailed above, Applicants inadvertently failed to include the actual drawings in the case as filed on February 6, 2001. This is clearly demonstrated by the fact that the specification included the "Brief Description of the Drawings" and referred to the various figures throughout the specification (indeed, the detail provided in the specification is such that inclusion of the drawings now do not constitute new matter). If Applicants had intended to omit the drawings, they would have modified the specification to eliminate references to the drawings. Such an oversight, especially when it is considered that the drawings were actually in possession of the United States Patent and Trademark Office with the provisional applications, should not incur the loss of the filing date. Since the drawings submitted with the Petition could easily be compared with the drawings submitted with the provisional applications, the determination that no new matter is being introduced in inclusion of the drawings can easily be confirmed. Thus the burden on the Office in confirming that no new matter has been introduced would be very small.


Applicants, therefore, respectfully request reconsideration of the Decision on Petition dated June 25, 2002. Applicants also respectfully request that the drawings enclosed with the original Petition be included with the application and that the original filing date of February 6, 2001, be granted to the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. 06-1135.

³ Should it be more appropriate, Applicants respectfully request that this Request for Reconsideration be considered as a Petition under 37 CFR 1.182 or 1.183 as appropriate. The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. 06-1135.

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Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY



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Date: October 25, 2002

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